

INTERVIEW

The courtesy of the Examiner and her Supervisor (hereinafter "Patent Office Representatives") in conducting an interview on May 4, 1999 is appreciated.

The Interview Summary given to the undersigned at the interview correctly summarizes the interview.

The following comments are also added.

At the interview the Patent Office Representatives considered that the reference to Govannoli did "meet the claims" in accordance with 35 USC § 102. To alleviate the concerns of the Patent Office Representatives base claims 1 and 19 have been amended along the lines suggested at the interview.

**With respect to claim 10, that claim has not been amended because it is considered that the Govannoli reference does not anticipate this claim for the reasons set forth in the Reply.**

Also at the interview, the term "ranking" was discussed. It was the undersigned position that the term "ranking" as understood by one skilled in the art would not include the structural steps in the reference. The undersigned did mention the case of "Medzam" and for the convenience of the Patent Office Representatives that case is cited as follows Multiform Dessiccants Inc. V. Medzam, Ltd. 45 USPQ 2d, 1429, 1433 Fed Cir. 1998 wherein the Court stated as follows:

"Courts must exercise caution lest dictionary definitions, usually the least controversial source of extrinsic evidence, be converted into technical terms of art having legal, not linguistic, significance. The best source for understanding a technical term is the specification from which it arose..."

In summation, the above-mentioned case directs that "ranking" must be given its meaning as defined in the specification which would not "read on" the steps or structure in the reference.

Also, the Patent Office Representatives asserted that there was a strong possibility that the added limitations to the claims may be considered obvious. In analyzing whether the claims are obvious or not from additional art, the Patent Office is requested to consider the doctrine set forth in the case of *Hybritech, Inc. V. Monoclonal Antibodies, Inc.*, 231 USPQ 81, 93 (Fed Cir. 1986) wherein the Court stated "that focusing on the obviousness of the differences between the claimed invention and the prior art rather than on the obviousness of the claimed invention as a whole as 35 USC § 103 requires" was improper in rejecting a claim.

#### **INFORMATION DISCLOSURE STATEMENT**

The indication that the PTO-1449 was not submitted with the papers previously filed is noted. It is understood that the

documents were submitted by the applicant. Accompanying this Reply is a PTO-1449 Form listing the documents. The Examiner is requested to match the documents previously submitted with the documents listed on the PTO-1449 Form and initial the PTO-1449 Form and return the same in the next communication from the Patent Office.

The Examiner's treatment of the documents, even without the PTO-1449 Form, is greatly appreciated and expedites prosecution of this application.

#### DRAWINGS

The indication that the drawings were informal is noted. Also, the receipt of the PTO-948 Form indicating the informality of the drawings is noted.

When this application is allowed, formal drawings will be submitted.

It is noted that a drawing correction was required for Figure 8. Accompanying this Reply is a Letter for Correcting the Drawings with respect to Figure 8.

The Examiner is requested to approve this drawing correction, but hold it in abeyance until this application is allowed.

**REPLY TO OBJECTIONS**

**First Objection**

In Section 4 of the Office Action, the disclosure was objected to. The correction suggested by the Examiner has been made.

The Examiner is requested to reconsider and withdraw the objection to the disclosure (Specification).

**Second Objection**

Claim 19 was objected to for the reasons set forth in paragraph 5 of the Office Action. Correction has been made to claim 19.

The Examiner is requested to reconsider and withdraw the objection to claim 19.

**REPLY TO REJECTIONS**

**First Rejection**

Claims 1-7 and 10-16 were rejected under 35 U.S.C. § 102(e) as being anticipated by Giovannoli (U.S. Patent No. 5,758,328). This rejection is traversed.

Each and every limitation of the claims is not shown in the reference either specifically or inherently, accordingly a rejection under 35 USC § 102 is not viable.

For example, in base claim 1, it is required in 1(f) that "ranking the sellers based upon the compiled information including the plurality of criteria and selecting sellers with the relatively highest ranking" is claimed.

What this refers to is that the information that was received from the sellers, which was based on the criteria of the buyer, is ranked according to the criteria of the buyer. This is generally set forth in the Specification on page 4.

For example, when a buyer is interested in buying a particular item there are certain criteria that may be important to the buyer for example, location, price, and service reputation. These criteria vary between different buyers, as some buyers are interested in buying only from a seller that has a good service reputation. Other buyers are interested in location. While, still, other buyers are interested in price. Of course, all of these exemplified criteria could be important to any buyer and he would list them based on his own preference of what each criteria has an importance relative to the buyer's preference.

Once the information is received from the sellers, ranking the sellers is done based on the compiled information. For example, some seller may have the highest service reputation and this might be a first rated criteria of one of the buyers. Based on this information, the seller with the highest ranking

for service reputation would be ranked the highest while other sellers with a lower service reputation, even though they had a better location and/or price, would be ranked lower.

This explanation above is only an example of the criteria that could be used. This concept is set forth positively in base claim 1 which is a method claim and which is a system claim and provides a "computation means for compiling information provided in the response received within the predetermined time interval for ranking the sellers based upon the compiled information, and for selecting the sellers with the relatively highest ranking" (emphasis added).

With respect to claim 10, which has not been amended, the "ranking concept" is set forth in an apparatus format. The ranking of the sellers does not find a response on the reference applied.

The limitations explained above do not find a response from the reference applied, accordingly, a rejection under 35 U.S.C. § 102 is not proper legally or factually.

It is well settled that a rejection based on 35 U.S.C. § 102 must disclose clearly the combination claimed. See, Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 771,218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984), overruled in part on other grounds by SRI Int'l v. Matsushita Elec. Corp. of Am., 775 F.2d 1107, 1125, 227 USPQ 577, 588 (Fed. Cir. 1985).

Also, there is nothing in the reference to indicate that the limitation with respect to the ranking of the sellers is inherently disclosed. See, Continental Can Co. USA Inc. v. Monsanto Co., 948 F.2d 1264, 1268-69, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991) wherein the court held as follows:

To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled . . . . [such] that the missing . . . . reference, and that it would be so recognized by persons of ordinary skill. . . . "Inherency . . . . may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. . . ."

With respect to the dependent claims on claims 1 and 10, these claims in the first instance are considered patentable at least for the same reasons as their base claim or intervening claims. Base claim 1 has been amended to provide a "plurality of criteria" which is not obvious in the context claimed from the references.

For the reasons set forth above, the Examiner is requested to reconsider and withdraw the rejection of the claims under 35 U.S.C. § 102.

### **Second Rejection**

Claims 8, 9, 17, and 18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Giovannoli as applied to

claims 7 and 16 above, and further in view of "Best's Review" (Insurer's venture onto the Internet web, July 1995) and "Link-Up" (Consumers buy cars via Auto-By-Tel, May 1996). This rejection is traversed.

The addition of the two secondary references does not supply the deficiencies of the rejection based on Giovannoli as explained above. Also, the Examiner's attention is directed to Figure 2a of Giovannoli and column 2, line 5 with respect to appliances and insurance. Also, base claim 1 has been amended to call for the "plurality of criteria" as explained in the first rejection supra.

For the reasons set forth above, the Examiner is requested to reconsider and withdraw the rejection of the claims under 35 U.S.C. § 103.

### **Third Rejection**

Claims 19 and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Giovannoli, and further in view of "Link-Up" article. This rejection is traversed.

As explained above, the base reference does not disclose selecting providers with the relatively highest ranking. This is found, for example, in claim 19, the next to the last paragraph, and is a function of the computation means.



Additionally, the article to "Link-Up" does not supply the deficiencies of the rejection based on the base reference.

The Examiner is requested to reconsider and withdraw the rejection of the claims under 35 U.S.C. § 103.

CONCLUSION

Should the Examiner have any questions concerning this application, the Examiner is invited to contact Elliot A. Goldberg at (703) 205-8000 in the Washington, D.C. area.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. 1.16 or under 37 C.F.R. 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By: 

Donald J. Daley

Reg. No. 34,313

P.O. Box 747

Falls Church, VA 22040-0747

(703) 205-8000

TCB/DJD/EAG/clg